

REMARKS

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and the following commentary.

I. Status of the Claims

Claim 1 has been amended with support in the original specification, for instance, at page 40 and in Examples 3 and 4. Claims 2, 3, 5, 7, 8 and 10 were cancelled before. Claims 6 and 9 are cancelled presently, without prejudice or disclaimer. Applicants reserve the right to pursue the subject matter of any cancelled claim in one or more continuing applications.

Because no new matter is introduced, applicants respectfully request entry of this amendment. Upon entry, claims 1, 4, and 11-15 will be pending, with claims 11-13 withdrawn from examination.

II. Rejection of Claims under 35 U.S.C. §112, first paragraph

The examiner rejected claims 1, 4, 6, 9 and 14-15 for alleged lack of written-description support in the specification. In particular, the examiner asserts that the recitation of “scions for rooting” in claims 1 and 6 introduces new matter into the claims.

Without acquiescing to the stated basis for this rejection, applicants choose to advance prosecution by deleting the phrase in question, thereby rendering the rejection moot.

III. Rejection of Claims under 35 U.S.C. §102

A. Kasuga

The examiner still alleges anticipation of claims 1, 4, 6, 9, 14 and 15 by Kasuga *et al.*, *Nature Biotechnology* 17: 287-91 (1999). Applicants respectfully traverse the rejection.

The claimed method entails the steps of (a) providing a transformed plant material, (b) obtaining a scion from a mother plant produced from the plant material, and then (c) producing a plant from the scion, such that the plant has the desirable characteristics.

By contrast, Kasuga describes that *Arabidopsis* plants were transformed to express DREB1A cDNA under the control of a modified 35S CaMV promoter or the stress-inducible rd29A promoter. See page 287, right column, last 4 lines. Subsequently, the growth of the transformants was compared with that of the wild-type control plants. See page 288, left column. Accordingly, Kasuga fails even to suggest let alone to disclose recited steps (b) and (c).

B. '742 patent

The examiner also asserts lack of novelty for claims 1, 4, 6, 9, 14 and 15 over U.S. Patent No. 6,495,742 to Shinozaki *et al.* Applicants likewise traverse the rejection.

The claimed invention is discussed above. The '742 patent discloses genes encoding plant transcription factors. More specifically, DREB1A and DREB2A genes are isolated and then used to transform *Arabidopsis thaliana*. See Examples 2 and 5. Subsequently, the transformants are tested for tolerance to the growth condition, such as dehydration/freezing tolerance. See Example 6. Like Kasuga, the '742 patent has no suggestion of recited step (b) and step (c), respectively.

C. '528 patent

The examiner has rejected the claims for alleged anticipation by U.S. Patent No. 6,670,528 to Shinozaki *et al.* Applicants respectfully traverse the rejection, too.

The '528 patent discloses that the plant transformants are tested for tolerance of the growth condition, but there is no teaching of steps (b) and (c) of the claimed method.

Because none of the cited references teaches each and every element of the claimed invention, withdrawal of these anticipation rejections are warranted.

IV. Rejection of Claim under 35 U.S.C. §103(a)

The examiner rejected claim 15 for alleged obviousness over (i) Kasuga in view of Dalton *et al.*, *Plant Science* 132:31-43 (1998), (ii) the '742 patent in view of Dalton, and (iii) the '528 patent in view of Dalton, respectively. Applicants traverse each ground of the rejection.

As demonstrated above, each of the primary reference fails to teach or suggest presently recited steps (b) and (c). Dalton is cited for disclosing silicon carbide whisker-mediated plant transformation, but the reference fails to compensate for the deficiencies of the primary references. Accordingly, applicants respectfully request withdrawal of the rejection.

V. Double Patenting Rejection

Claims 6 and 9 are rejected for obviousness-type double patenting over claims 1-4 of U.S. Patent No. 6,670,528 and over claim 6 of U.S. Patent No. 6,495,742. Claims 6 and 9 are cancelled, however, and so these rejections are obviated.

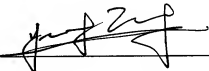
CONCLUSION

Applicants submit that the present application is in condition for allowance, and they request an early indication to this effect. Examiner Kumar is invited to contact the undersigned directly, should he feel that any issue warrants further consideration.

The Commissioner is hereby authorized to charge any additional fees, which may be required under 37 C.F.R. §§ 1.16-1.17, and to credit any overpayment to Deposit Account No. 19-0741. Should no proper payment accompany this response, then the Commissioner is authorized to charge the unpaid amount to the same deposit account. If any extension is needed for timely acceptance of submitted papers, then applicants hereby petition for such extension under 37 C.F.R. §1.136 and authorize payment of the relevant fee(s) from the deposit account.

Respectfully submitted,

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